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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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TOWNSEND AND TOWNSEND AND CREW, LLP			GITLIN, MATTHEW J	
TWO EMBARCADERO CENTER				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/593,057	KNAUSEDER, FRANZ	
	Examiner	Art Unit	
	Matthew J. Gitlin	3635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 29 September 2008.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-36 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on N/A is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>9/15/2006</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

Drawings

1. The subject matter of this application admits of illustration by a drawing to facilitate understanding of the invention. Applicant is required to furnish a drawing under 37 CFR 1.81(c). No new matter may be introduced in the required drawing. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d).

Priority

2. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Austria on 03/23/2004. It is noted, however, that applicant has not filed a certified copy of the A511/2004 application as required by 35 U.S.C. 119(b).

Claim Objections

3. **Claims 1-36** are objected to because of the following informalities:

- **Claims 1-36;** any instance of "(s)" on the end of a noun is to be amended to a plurality or single to provide consistent antecedent basis.

4. **Claim 1** is objected to because of the following informalities:

- Line 1, the phrase "Covering panel(s)" should be written out "One or more covering panels" if one or more panels are to be claimed, or "A plurality of covering panels" if a plurality are to be claimed. it appears that since more than one panels are referred to later in the claim, then the claim was meant to be written as a "plurality." As written, the phrase is indefinite.

- Line 3, the term “bonded chips” should not be modified by the term “(particle board).” Parentheses can only be used in a Claim to represent numerals in figures. It is recommended that the claim read – artificial resin, bonded chips, or particle board,
--
- Line 6, the phrase "panels to be joined together" is merely an intention of the Claimed elements. This is better read -- panels configured to be joined together –
- Line 14, the phrase “formed in that inner wall surface” should read “wherein the detent surface is formed in an inner wall surface of the groove and faces the tongue surface.”
- Line 15, the phrase “into which detent recess the bead or web projects, when the tongue is inserted into the groove” should read “said bead or web projects into said detent recess when the tongue is inserted into the groove.”
- Line 16, the phrase “or by which detent recess (5) that portion (10) of the bead (8) which projects from the recess (3) is encompassed or received,” should read “or a portion of said bead is encompassed or received in said detent recess”.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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6. **Claims 1-36** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. **Claims 1-36;** Any instance of "and/or" in these claims is indefinite. It is unclear if Applicant is claiming the limitations together or in the alternative. It is suggested that the use of "and/or" be changed to "and" or "or" or where needed "and" to comply and provide antecedent basis of a prior claim.

8. **Claims 1-36;** Any instance of "preferably" in the claims needs to be amended. A personal preference does not necessarily further limit the claim and therefore leads them to be indefinite. If a positive recitation of structure is desired, "preferably" should be removed from a Claim.

9. **Claim 1, Line 4** states the phrase "a groove ... and/or a tongue." Since Claim 1 requires both a tongue and groove as later referenced in the Claim, then a tongue can not be optional. This leaves the Claim indefinite. This phrase will be treated as "a groove ... and a tongue."

10. **Claim 1, Lines 7-8** states the phrase "in the course of a displacement which substantially takes place in the panel plane." This phrase is not understood as to the bearing of the aforementioned structure and therefore deems the claim indefinite.

11. **Claim 3; Line 4,** the phrase "the surface of the panels" is indefinite. It is not understood which surface is being referenced.

12. **Claim 3; Line 5,** the phrase "extend under the same angle as the associated tongue surfaces" is indefinite. It is not understood which angle is being referenced.

13. **Claims 8-9 and 19;** the terms “groove legs” or “leg of the groove” lack antecedent basis in the Claims.

14. **Claim 11,** the phrase “the region of the upper surfaces or surfaces of use” is indefinite and lacks antecedent basis. The phrase “of use” needs to be more descriptive, there is no use defined previously. The examiner will assume these surfaces to be the engaging surfaces of the upper parts of the tongue and groove.

15. **Claim 27;** It is claimed that “an inclination angle of 95 to 105°, preferably of 97 to 103°, and in particular is perpendicular to the surface.” This is indefinite, since a range of angles can not be claimed that does not include 90 degrees, and then claimed to be “in particular perpendicular.”

Appropriate correction is required.

Claim Rejections - 35 USC § 102

16. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

17. **Claims 1-17, 19-22, 25-26 and 28-36** are rejected under 35 U.S.C. 102(e) as being unpatentable by Sjoberg et al. (US 2004/0182036).

18. **Claim 1;** Sjoberg discloses a plurality of covering panels (1) for floors, walls and ceilings (**Paragraph [0002]**), formed wood based material like fiber board, particle board, chip board,

oriented strand board or massive wood (**Paragraph [0034]**), the covering panels comprising a groove (**30**) along at least one edge or front surface (**Figs. 4a-4c**) and a tongue (**29**) along at least one different edge or front surface (**Figs. 4a-4c**), panels configured to be joined together being interconnectable by inserting the tongue into the groove, and a bead (**27'**) of a non-curing thermoplastic elastomeric sealant (**Paragraph [0032]**) being applied (**Figs. 4a-4c**) to at least one tongue surface (**Figs. 4b-4c**), wherein a recess (**26'**) is formed in the tongue surface (**Fig. 4a**) and receives in part said bead (**As displayed in Fig. 4b**), and a detent recess (**27**), delimited by a detent surface (**Sidewall of 27 in fig. 4a**), wherein the detent surface is formed in an inner wall surface of the groove (**Fig. 4a**) and faces the tongue surface (**Fig. 4a**), said bead or web projects into said detent recess when the tongue is inserted into the groove (**Fig. 4b**), so that the bead and the detent surface, after insertion of the tongue into the groove, can be interlocked and/or interconnected (**As displayed in Figs. 4b-4c**).

19. **Claim 2;** Sjoberg discloses wherein the groove and the tongue are each formed on a longitudinal side and on a transverse side of a panel (**Paragraph [0005]**).

20. **Claim 3;** Sjoberg discloses wherein the thickness of the tongue decreases towards the free end (**Fig. 4a**), wherein at least one tongue surface is inclined relative to the surface of the panels (**Angled end surface as seen in Fig. 4a**) and the wall surface of the groove extend under the same angle as the associated or engaging tongue surfaces (**Fig. 4a**).

21. **Claim 4;** Sjoberg discloses wherein the tongue and the groove can be interconnected, at least over part of the surfaces facing each other, in a positive way or with a snug fit (**Figs. 4a-4c**).

22. **Claim 5;** Sjoberg discloses edges provided with joining means for positioning the panels towards one another. Predetermined portions of the edges are provided with a layer of polymer.

The panels are joined to one another by use of the joining means where the polymer forms a seal in the joint preventing penetration of water into the joint wherein a highly water resistant unit of a plurality of panels is formed (**Paragraph [0004]**).

23. **Claim 6;** Sjoberg discloses a groove in said tongue with an opening larger than a base (**As displayed in the right side of Fig. 2**).

24. **Claim 7;** Sjoberg discloses wherein said bead is a contact glue which normally is of a nitril rubber type (**Paragraph [0008]**).

25. **Claim 8;** Sjoberg discloses the it is advantageous to use a polymer with good storage stability and which do not dry out or form skin before the installation (**Paragraph [0007]**) and which acts as a locking element against escaping of the tongue from the groove (**As displayed in Fig 4c**).

26. **Claim 9;** Sjoberg discloses wherein legs of the grooves have an equal length (**Upper and lower legs of Groove in Figs. 4a-4c**).

27. **Claim 10;** Sjoberg discloses wherein the groove and tongue are formed of the material of the panel (**Core material as seen in Figs. 4a-4c**).

51. **Claim 11;** Sjoberg discloses wherein the upper surfaces of the tongue and groove engage during interlocking (**Fig. 4b**) and wherein a gap is formed towards the innermost part of the groove when the tongue and groove are engaged (**As displayed in Fig. 4c**).

52. **Claim 12;** Sjoberg discloses wherein a part of the bead which projects from the recess is formed of a rounded contour (**As seen in Fig. 4b**).

62. **Claim 13;** Sjoberg discloses wherein the projecting portion of the bead acts as a locking portion (**Fig. 4c**).

63. ***Claim 14;*** Since Sjoberg discloses a plastic bead material as seen in the rejection to Claim 1, Claim 14 does not further limit Claim 1 and is therefore included in the current rejection.

64. ***Claim 15;*** Sjoberg discloses wherein the bead firmly adheres in the recess (**As displayed in Fig. 4b-4c**).

65. ***Claim 16;*** Sjoberg discloses wherein the bead engages the detent surface and the groove surface in a pressure biasing manner (**As displayed in Figs. 4b-4c**).

66. ***Claim 17;*** Since Sjoberg discloses a plastic bead material as seen in the rejection to Claim 1, Claim 17 does not further limit Claim 1 and is therefore included in the current rejection.

67. ***Claim 19;*** Sjoberg discloses wherein the detent recess is formed only in the wall surface of a lower leg of the groove (**Figs. 4a-4c**).

68. ***Claim 20;*** Sjoberg discloses wherein the bead and the detent surface of the detent recess grip behind one another (**As displayed in Figs. 4b-4c**).

69. ***Claim 21;*** Sjoberg discloses wherein in a locked position (**Figs. 4b-4c**) the bead is under a force bias by at least one groove leg (**26**).

70. ***Claim 22;*** Sjoberg discloses wherein the bead extends parallel to and along the edges of the front surface of the panel(**Direction of extension shown transverse to the plane displayed in Figs. 4a-4c**).

71. ***Claim 25;*** Sjoberg discloses wherein the cross-section of that portion of the bead which projects from the recess is rounded in a circular shaped fashion (**Rounded fashion as displayed in Figs. 4b-4c**).

72. **Claim 26;** Sjoberg discloses wherein the recess is formed in a region of the tongue which stands back from the tongue surface in the direction to the front surface of the panel (**as displayed in Figures 4a-4c).**

73. **Claim 28;** Sjoberg discloses wherein the transition from the inner wall surface of the groove, which delimits the detent recess, to the detent surface, is rounded (**Upper corner of 27 as seen in Fig. 4a).**

74. **Claim 29;** Sjoberg discloses a gap between a surface of the groove and the bead (**As displayed in Figs. 4b-4c) between a transition area and the bead.**

75. **Claim 30;** Sjoberg discloses wherein the bead comprises a tongue (**Upper right portion of bead in Fig. 4b) which engages the detent surface (Fig. 4b).**

76. **Claim 31;** Sjoberg discloses wherein the terminal region of the recess () is situated opposite the detent surface (**Opposing horizontal surfaces in Fig. 4a).**

77. **Claim 32;** Sjoberg discloses wherein the region of the front surfaces (**25^{II}) above the groove near the upper surface includes a stop (31) for delimiting the insertion of the tongue into the groove wherein at least one spacer is arranged which determines the distance of the opposite front surfaces of the panels to be interconnected (Fig. 4b).**

78. **Claim 33;** Sjoberg discloses wherein a portion of the groove surface extends over the recess engages the bead (**Surfaces engaging bead in Figs. 4a-4c).**

79. **Claim 34;** Sjoberg discloses wherein a front surface of the groove leg is rounded (**Front lower surface as displayed in Fig. 4a).**

80. ***Claim 35;*** Sjoberg discloses wherein the detent recess and the recess and the bead (**All parallel vertical surfaces as seen in Fig. 4a**) extend at least along a portion parallel to the respective front surface (**Fig. 4a**).

81. ***Claim 36;*** Sjoberg discloses wherein a free space (**Fig. 4b**) is formed by the recess between the bead and the inner surfaces of the recess, which join the tongue surface and extend into the interior of the tongue (**Fig. 4b**).

Claim Rejections - 35 USC § 103

82. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

83. **Claims 18, 23-24 and 27** are rejected under 35 U.S.C. 103(a) as being unpatentable over Sjoberg et al. (US 2004/0182036).

84. ***Claim 18;*** Sjoberg does not expressly disclose wherein said bead is applied with a substantially uniform layer thickness of 0.5 to 0.9 mm, particularly of 0.6 to 0.8 mm, with thickness tolerances in the range of +0.05 to 0.1 mm.

At the time of the invention it would have been obvious to a person having ordinary skill in the art to try and provide the bead of Sjoberg, with a uniform thickness measuring 0.5 to 0.9 mm, particularly of 0.6 to 0.8 mm, with thickness tolerances in the range of +0.05 to 0.1 mm,

since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose, 105 USPQ 237 (CCPA 1955)*.

85. **Claim 23;** Sjoberg does not expressly disclose wherein the recess in the tongue has a triangular cross-section, the area of the inner triangle edge being optionally rounded.

At the time of the invention it would have been obvious to a person having ordinary skill in the art to try and modify the recess of Sjoberg so that it displays a triangular cross-section, the area of the inner triangle edge being optionally rounded, since this would only require a minor modification of the intersecting dimensions of the recess of Sjoberg and would provide the same holding and connecting function as disclosed by Sjoberg.

86. **Claim 24;** Sjoberg does not expressly disclose wherein the depth of the recess amounts to 30 to 55%, preferably 36 to 48%, of the total thickness or height of the bead.

At the time of the invention it would have been obvious to a person having ordinary skill in the art to try and provide the bead of Sjoberg, with wherein the depth of the recess amounts to 30 to 55%, preferably 36 to 48%, of the total thickness or height of the bead, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose, 105 USPQ 237 (CCPA 1955)*.

87. **Claim 27;** Sjoberg discloses wherein the detent surface is formed by a prolongation of the inner wall surface of the groove (27, **Fig 4a**), and is inclined to the surface of the panel (**Leftmost surface of detent, Fig. 4a**) but does not expressly disclose an inclination angle of 95 to 105°, preferably of 97 to 103°.

At the time of the invention it would have been obvious to a person having ordinary skill in the art to try and provide the bead of Sjoberg, with wherein an inclination angle of 95 to 105°, preferably of 97 to 103°, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose, 105 USPQ 237 (CCPA 1955)*.

Double Patenting

88. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned

with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

89. **Claim 1** is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over **claim 66 of U.S. Patent No. 7,188,456**. Although the conflicting claims are not identical, they are not patentably distinct from each other because:

90. **Claim 66 of US 7,188,456** discloses a cladding panel for coupling with an adjacent complementary panel, the cladding panel comprising: a tongue portion extending from a first edge of the cladding panel for receipt in a groove in a complementary cladding panel; a groove portion having walls extending in a second edge of the cladding panel for receiving a tongue portion of a complementary cladding panel; at least one linear deposit of applied adhesive configured as at least one solid bead or line deposited on one of the portions, the applied adhesive being of a hardness and a viscosity sufficient to withstand insertion of the tongue portion into the groove portion without significant change of shape, and at least one recess on the other portion for receiving the linear deposit of applied adhesive therein to initially positively latch the tongue and groove portions together when the cladding panel is coupled with a complementary cladding panel.

1. **US 7,188,456** does not expressly disclose wherein the panels are formed of wood, wood material, MDF, HDF, plastic material, recycled plastics, chips with artificial resin, bonded chips, or particle board.

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At the time of the invention it would have been obvious to a person having ordinary skill in the art to try and provide the panel of **US 7,188,456** with a material formed of wood, wood material, MDF, HDF, plastic material, recycled plastics, chips with artificial resin, bonded chips, or particle board, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin, 125 USPQ 416.*

Conclusion

91. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

92. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J. Gitlin whose telephone number is (571)270-5525. The examiner can normally be reached on Monday - Friday (7:30am-5:00pm EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on (571)272-6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. J. G./
Examiner, Art Unit 3635

/Robert J Canfield/
for R. Chilcot, SPE of Art Unit 3635